



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,880	12/31/2003	Yuvaraj Athur Raghuvir	11884/405701	8889

26646 7590 09/20/2006

KENYON & KENYON LLP  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER
----------

KIMBALL, MAKAYLA T

ART UNIT	PAPER NUMBER
----------	--------------

2191

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/749,880

**Applicant(s)**

RAGHUVIR ET AL.

**Examiner**

Makayla Kimball

**Art Unit**

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-16 are pending and are considered below.

#### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "150" has been used to designate both "Application Developer" and "Testing Module" in Figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "805" and "830" have both been used to designate "Start" in Figure 8. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. Figures 3 and 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

5. The disclosure is objected to because of the following informalities: On pg. 12, "CangeMgrTC 1005(6)" is not shown in Figure 11 also on pg. 12, "'ARSTestSuite class 1105(1)" is not shown in Figure 9. On pg. 14, "1020, setUnreachableStates for the TC is called", Figure 10 only mentions "1020" as "setReachable"

Appropriate correction is required.

#### ***Claim Objections***

6. Claims 1, 6-11 and 16 are objected to because of the following informalities: Claims 7-10 should be system instead of method. Claims 1, 6, 11, and 16 do not have "and" before final step in claim.

i.e. In claim 1:

receiving ranking information for the test scenario...selected test case classes; and

Art Unit: 2194

performing a test of the test scenario...

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

9. A system claim needs to have more than one step. However, in claim 16 only comprises of a single test module.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 2, 7 and 12 recites the limitation "collaborative behavior". Examiner will interpret "collaborative behavior" to mean "many tests executing in certain order".

Art Unit: 2194

Claims 3, 8 and 13 recites the limitation "framework semantic". Examiner will interpret "framework semantic" to mean "tests that ran without any error".

Claims 5, 10 and 15 recites the limitation "valid nesting". Examiner will interpret "valid nesting" to mean "having structured tests". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claims 1, 6, 11 and 16 produce no concrete, tangible result. The independent claims are performing tests but there is no tangible result and not making use of the results, if any. For example, merely determining or calculating a price may not be held to be a tangible result, instead reasonably being interpreted as just a thought or a computation within a processor; however, calculating a price of an item to sell and then conveying the calculated price to a potential customer would be a tangible result. Claims 2-19, 21-38 and 40-57 are rejected under 101 because they are dependent upon independent claims 1, 20 and 39, respectively.

Claim 11 is claiming a program storage device could cover software alone, which is functional descriptive material, as such, is considered non-statutory.

Claim 16 is claiming a test module consisting of steps to perform, wherein the test module could cover software alone, which is functional descriptive material, as such, is considered non-statutory.

Art Unit: 2194

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Wybouw-Cognard (2002/0116153).

Note: For examination purposes, the examiner will interpret test scenario to mean test automation framework; test cases to mean test scenarios; operations to mean test applications; and classes to mean tests.

Claims 1, 6 and 11:

A method for testing a software application comprising:

Associating a test case class [0009, "at least one test scenario] with each of a plurality of operations; [0009, "including a test application"; 0034, "plurality of test applications"]

Receiving a test scenario [0008, "provided a test automation framework"], the test scenario including at least one selected test case class; [0009, "at least one test scenario"]

Receiving ranking information for the test scenario, the ranking information pertaining to relative prioritization of execution of each of the selected test case classes [0029, "The test automation framework may carry out the tests in the order of the test applications"; 0064, "the framework determines the order of execution"]; and

Performing a test of the test scenario as a function of the ranking information. [0055, "configure tests according to the requirements of the test applications"]

Art Unit: 2194

Claims 2, 7 and 12:

The method according to claim 1, wherein each operation includes a collaborative behavior of a plurality of classes. [0063, "plurality of tests"; 0065, "first selects a test according to the execution order"]

Claims 3, 8 and 13:

The method according to claim 1, wherein the ranking information is validated to be semantically correct with respect to a framework semantics. [0030, "performing sanity check on the results of the input selection means and, in the case of an error, aborting all tests and reporting an error"]

Claims 4, 9 and 14:

The method according to claim 3, wherein the ranking information is validated to be semantically correct by defining valid start states and probable end states for each associated operation. [0015, "verify means for operating a verify process for verifying the results of the test application according to the results of the input selection means"]

Claims 5, 10 and 15:

The method according to claim 3, wherein the ranking information is validated to be semantically correct with respect to a framework semantics by providing an editor that allows only valid nesting of test cases. [0025, "framework provides a structure by which the tests may be conducted...structure the prepare, run and verify processes according to requirements."]



Art Unit: 2194

Claim 16:

A system for testing software application comprising:

A test module, the test module:

Defining at least one test case class [0009, "at least one test scenario] for each of a plurality of operations, [0009, "including a test application"; 0034, "plurality of test applications"] wherein the operation is characterized as having a beginning and an end; [0015, "verify means for operating a verify process for verifying the results of the test application according to the results of the input selection means"]

Receiving first information describing valid start states and probable end states for each test case class; [0015, "verify means for operating a verify process for verifying the results of the test application according to the results of the input selection means"]

Receiving second information for relating at least a portion of the test case classes to reflect a particular scenario for testing; and [0116, "allows a developer to define particular times of test scenario for use in testing without having to individually specify each test scenario"]

Performing a test of the particular scenario as a function of the first information and second information. [0055, "configure tests according to the requirements of the test applications"]

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Logan (US Patent 6,601,018) – discloses an automatic test framework.

"Object Oriented Framework Development" – discloses framework testing.

Art Unit: 2194

Bahrs et al (US PGPUB 2003/0097650) – discloses a method and apparatus for testing software.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Makayla Kimball whose telephone number is 571-270-1057. The examiner can normally be reached on Monday - Thursday 10AM - 3PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MTK  
MTK  
09/14/2006

  
James W. Myhre  
Supervisory Patent Examiner